

REMARKS

Favorable reconsideration is respectfully requested in view of the foregoing amendments and the following remarks.

I. CLAIM STATUS AND AMENDMENTS

Claims 1-24 were pending in this application when last examined.

Claims 1-12, 14-15 and 20 were examined on the merits and rejected.

Claims 13, 16-19 and 21-24 were withdrawn as non-elected subject matter.

Claims 1, 2, 6, 7, 10, 11, 14 and 20 are amended.

The terms "hydrocarbon group" and "substituents" in the claims are amended to recite particular species. Support for these amendments can be found as follows:

- support for Ring A: from page 13, line 7 to page 15, line 2, and Examples;
- support for Ring B: from page 15, line 12 to page 17, line 10, and Examples;
- support for W: from page 18, line 2 to page 23, line 9, and Examples;
- support for R: page 23, lines 10-19, from page 24, line 12 to page 35, line 13, and Examples;
- support for D₁ and D₂: page 23, lines 20-29, and from page 24, line 12 to page 29, line 16; and Examples; and
- support for Y: from page 23, line 30 to page 33, line 23, and Examples.

The claims have also been amended to delete non-elected subject matter.

Furthermore, the compound of Example 31 has been excluded from the claimed invention by deleting "a bond" from the definition of D₁.

In Claim 20, the term "prophylaxis or" has been deleted.

Claims 3, 9, 13, 16-19 and 21-24 are cancelled. Applicants reserve the right to file a continuation or divisional application on any cancelled subject matter.

The specification has been amended to correct an obvious typographical error on page 46, lines 7-9.

No new matter has been added.

II. OBVIOUSNESS REJECTION

On page 3 of the Office Action, claims 1-12, 14-15 and 20 were rejected under 35 USC 103(a) as obvious over Rainer et al. (U.S. 4,686,230). Applicants respectfully traverse this rejection as applied to the amended claims. Further, a Rule 132 Declaration demonstrating the claimed compounds have the property of unexpectedly hydrolyzing to a much greater percentage than the cited compounds is attached.

As indicated by the Examiner, the compound of the formula (I) of the present invention is generically encompassed in the broad scope of Rainer et al. (*hereinafter* '230). However, '230 does not specifically teach a compound having a substituent of a specific structure of $-(C=X_1)-N(R)(-W-D_1-(C=X_2)-D_2-Y)$ at the nitrogen atom on the benzimidazole ring, as the compound specified by claim 1 of the present invention.

'230 exemplifies "substituted carbamoyl" as one of the groups represented by R^5 of the formula (I) (column 3, lines 43 and 44), but specifically discloses only "phenylcarbamoyl" and "dimethylcarbamoyl" as specific examples thereof (column 3, lines 45 and 46). '230 does not specifically disclose, as R^5 , a substituted carbamoyl having $-W-D_1-(C=X_2)-D_2-Y$ as a substituent. Accordingly, the compound of the present invention is not specifically taught or suggested by '230.

In order to establish the non-obviousness of the present invention, the Applicants herein submit a Rule 132 Declaration that shows the unexpected effect of the present invention over '230.

In the attached Declaration, hydrolysis tests using hepatic S9 and intestinal S9 were performed on the Example compounds of the present invention, and N,N-dimethyl-2-[[[3-methyl-4-(2,2,2-trifluoroethoxy)-2-pyridyl]methyl]sulfinyl]-1H-benzimidazol-1-carboxamide, which has a dimethylcarbamoyl group at R^5 of the compound (I) disclosed in '230 (Compound A in the Declaration).

The Declaration shows that that the Example compounds of the present invention are

mostly hydrolyzed to form a parent compound (lansoprazole), whereas Compound A is hardly hydrolyzed. Therefore, the compound as suggested by '230 does not effectively act as a prodrug. Thus, the Declaration shows that the claimed compounds unexpectedly hydrolyze into the parent compound to a much larger percentage than the compound of '230.

Thus, Rainer et al. fails to disclose or suggest the claimed invention because (1) Rainer fails to specifically teach the claimed compounds and (2) Rainer fails to teach or suggest the unexpectedly large percentage of the claimed compounds that hydrolyze into the parent compound. Applicants therefore suggest that this rejection, as applied to the amended claims, is untenable and should be withdrawn.

III. ENABLEMENT AND WRITTEN DESCRIPTION REJECTIONS

On page 4, claim 20 was rejected under 35 USC 112, first paragraph, on the basis that the specification is enabling for treatment of peptic ulcers but is not enabling for prevention of peptic ulcers. Claim 20 is amended to delete the term "prophylaxis" and therefore this rejection is moot.

Further, on page 6, claims 1-4, 7, 9-11 and 14 were rejected under 35 USC 112, first paragraph, as failing to comply with the enablement requirement. In order to overcome this rejection, Applicants have amended the claims to more specifically recite particular species of "hydrocarbon groups" and "substituents". Therefore Applicants suggest that this rejection, as applied to the amended claims, is untenable and should be withdrawn.

Finally, on page 9, claims 1-4, 7, 9-11 and 14 were rejected under 35 USC 112, second paragraph, as being indefinite for the terms "hydrocarbon" and "substituents". As noted above, such claims have been amended to more specifically recite particular species for these terms. Thus, Applicants suggest that this rejection, as applied to the amended claims, is untenable and should be withdrawn.

Further, on page 6 the Office also rejected claim 18 as indefinite for 's' in "salts". Applicants have carefully reviewed the claims and are unable to locate such a term. Therefore Applicants respectfully request the Examiner to clarify this concern in the next Office Action.

IV. PROVISIONAL DOUBLE PATENTING REJECTION

On page 10, claims 1-12 were provisionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-15 of copending application Serial No. 10/517,847. Applicants respectfully request that the Examiner hold this ground of rejection in abeyance.

CONCLUSION

In view of the foregoing amendments and remarks, the present application is in condition for allowance and early notice to that effect is hereby requested.

If the Examiner has any comments or proposals for expediting prosecution, please contact the undersigned attorney at the telephone number below.

Respectfully submitted,

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